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DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
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Paper No. 5

In re Application of :
Jeffrey Fischer : DECISION ON PETITION
Application No. 09/827,698 :
Filed: April 6, 2001 :
Attorney Docket No. P00043601XX :

This is a decision on the petition filed on September 30, 2002 by which petitioner requests withdrawal of the holding that this application stands abandoned for failure to file a reply to the Office letter dated September 26, 2001. No fee is required for the petition.

The petition is granted.

Petitioner alleges that a reply to the Office letter in question was in fact filed on February 25, 2002, and that the reply was timely filed by reason of a concurrently filed petition for a two month extension of time and the fee for the extension. Petitioner supports this allegation by including a copy of the reply, which is a copy of a request for filing a continued prosecution application (CPA) together with a preliminary amendment. The CPA request includes the petition for the two month extension of time. Petitioner further supports the allegation of timely filing by including a copy of a filing receipt for these items which shows that they were actually received in the Office on February 25, 2002. In addition, Office financial records show that the CPA filing fee and the extension fee were in fact received in the Office.

It is clear that in light of the above showing, this application was not in fact abandoned. However, petitioner is advised that 37 CFR 1.53(d) provides, in pertinent part, that, a request for filing a CPA of a prior nonprovisional utility patent application is proper only in the event that the prior nonprovisional utility patent application was filed under 35 USC § 111(a) before May 29, 2000. See 37 CFR 1.53(d)(1)(i)(A). Therefore, the CPA request in this application was not a proper reply to the Office letter in question because the CPA request was improper. However, Office practice is to treat an improper CPA request as the filing of a request for continued examination (RCE) under 37 CFR 1.114. See MPEP § 706.07(h), subsection IV. "Improper CPA Treated as RCE".

Consideration of the reply filed on February 25, 2002 as a RCE under 37 CFR 1.114 shows that the RCE is also improper, because the prosecution in the application was not closed on February 25, 2002. See 37 CFR 1.114(a), which reads in pertinent part, "If prosecution in an application is closed ..." and 37 CFR 1.114(b) which defines the meaning of the phrase "prosecution in an application is closed". See also MPEP § 706.07(h), subsection I. "Conditions for Filing an RCE". However, pursuant to MPEP § 706.07(h), subsection III(A)(1), "Initial Processing - Treatment of Improper RCE - Prosecution Not Closed", applicant will be notified of the improper RCE, any amendment submitted with the improper RCE will be entered, and the application will be forwarded to the examiner for consideration of the amendment under 37 CFR 1.111.

Accordingly, the Notice of Abandonment is hereby vacated, the holding of abandonment is withdrawn, and the application is restored to pending status. The application is being forwarded to the Head Supervisory Applications Examiner for entry of the papers filed on February 25, 2002, including the mailing of a formal notice of the filing of an improper RCE.

Thereafter, the Head Supervisory Applications Examiner will enter the "preliminary" amendment filed on February 25, 2002 and forward the application to the examiner *via* the Supervisory Patent Examiner, for consideration pursuant to 37 CFR 1.111. If the amendment is considered to be responsive to the outstanding Office action within the meaning of 37 CFR 1.111, prosecution of the application will resume as though petitioner had simply filed an amendment in response to the outstanding action. If the examiner determines that the amendment is informal/nonresponsive to the outstanding Office action, then the examiner will treat the amendment in accordance with 37 CFR 1.135(c) as discussed in MPEP § 710.01.

PETITION GRANTED.


E. Rollins-Cross, Director, Patent
Examining Groups 3710 and 3720

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